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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/903,694 | 07/13/2001 | Narihiro Tahara | 1403-0212P | 9156 |
| 2292 | 7590 | 09/01/2005 | EXAMINER | |
| BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | YOON, TAE H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1714 | |
| DATE MAILED: 09/01/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,694

Applicant(s)

TAHARA ET AL.

Examiner

Tae H. Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Note new examiner.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP409241427A in view of EP 1 006 007.

JP teaches a tread rubber composition comprising a diene-based rubber, 0.5-40 pts.wt. of silicone resin particle and 30-80 pts.wt. of carbon black in abstract. Said composition provides excellent gripping properties on ice, and thus a tire would be studless. Aluminum hydroxide is optional component in the instant invention.

The instant invention further recites employing 2 to 30 parts by weight of glass fibers over JP. However, the use of various fillers such as glass fibers or mixtures thereof in rubber compositions for tire treads is well known as taught by EP, table 2.

It would have been obvious to one skilled in the art at the time of invention to utilize glass fibers of EP in JP409241427A in order to improve mechanical properties since one of the objectives of JP409241427A is to obtain reinforcing properties and since the use of glass fibers for a tire tread composition is a routine practice in the art.

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta et al (US 6,489,389 or EP 0 697 432) or EP 0 945 482 in view of EP 1 006 007.

Examiner points out US patent of Ohta et al.

Ohta et al teach a tread rubber composition comprising a diene-based rubber, oil, carbon black, silica and aluminum hydroxide in examples (tables). Said aluminum hydroxide has a particle size of 0.01-10 μm (col. 4, lines 39-47), and inherently possesses the recited Mohs hardness. Amounts of components taught by Ohta et al (claim 9) encompass the instant amount, and thus utilization of the instant amount would be a *prima facie* obviousness. The teaching (col. 1, lines 16-30) of Ohta et al implies a studless tire.

EP'482 teach similar compositions in table 2 and [0051] wherein employing other fillers are taught.

Silicone particle is optional component in the instant invention.

The instant invention further recites employing 2 to 30 parts by weight of glass fibers over Ohta et al and EP'482. However, the use of various fillers such as glass fibers or mixtures thereof in rubber compositions for tire treads is well known as taught by EP'007, table 2.

It would have been obvious to one skilled in the art at the time of invention to utilize glass fibers of EP'007 in Ohta et al or EP'482 in order to improve mechanical properties since Ohta et al and EP teach employing other additives at col. 6, lines 20-27

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and in [0051], respectively, and since the use of glass fibers for a tire tread composition is a routine practice in the art.

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholl (US 6,025,415) in view of Yagi (JP 2000178379 A).

Rejection is maintained for reason of record with following response.

Tire tread obtained by teaching of Scholl would be studless inherently since the use of studded tire is illegal in most of states in US.

With respect to Example 1 and Comparative Example 1, a fair comparison cannot be made since the Example 1 contains higher amounts of additives (total 75 parts) and one extra component (HIGILITE H43, aluminum hydroxide). Thus, unexpected result of employing glass fibers is inconclusive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/August 29, 2005